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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,702	08/04/2000	HIDEYOSHI HORIMAI	106357	8307

25944 7590 05/10/2002

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EXAMINER	
HENRY, JON W	

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 05/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 09/601,702	Applicant(s) HORIMAI, HIDEYOSHI
	Examiner Jon W. Henry	Art Unit 2872

-- The MAILING DATE of this c mmunication appears on the cover sheet with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) *3-5,9-15 and 18-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6-8,16 and 17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6 and 7* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that there would be no serious burden in the examiner searching and examining all of the claimed invention. This is not found persuasive because applicant's remarks merely jump from one conclusion to another without developing any clear argument. For example, applicant's remarks assert that "the subject matter of all claims is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims." Applicant provides no facts to support that conclusion. In fact, the divided inventions include separate features that would create a serious burden of searching and examining all of the claimed inventions, absent an allowable linking claim. Applicant's remarks continue, "Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden." However, applicant has not even addressed any issues of "examination" that might support drawing that conclusion.

Additionally, applicant's remarks quote MPEP 803 as the authority for the relevance of the unsupported conclusions, as set forth above. However, applicant's remarks fail to clarify how MPEP 803 may be relevant to a unity of invention requirement for division of inventions for examination purposes, as set out in the last Office action. As set out in MPEP 801, "This chapter [MPEP Chapter 800] is limited to a discussion of the subject of restriction and double patenting under Title 35 of the United States Code and Title 37 of the Cope of Federal Regulations as it relates to national applications filed under 35 U.S.C. 111(a)."

Finally, applicant's remarks conclude that the "delay and expense" that may well result from the division of inventions for examination purposes is "unnecessary" and to such "delay and expense" "and duplicative examination," division of the inventions should not be made. Applicant's remarks do not explain why such division is "unnecessary," or why examination of inventions with separate features would be "duplicative examination." Therefore, the requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-5, 9-15, and 18-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions.

Specification

3. The abstract of the disclosure is objected to because it is too long, is not one paragraph, and is not directed to the elected invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, and 6-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Horimai et al (U.S. Patent 5,917,798).

Claim Rejections - 35 USC § 103

6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being obvious over Horimai et al (U.S. Patent 5,917,798) in view of applicant's own disclosed prior art.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The addition of wavelength mutltiplexing would have been obvious as a well known technique for further reducing the interference between overlapped recording that would be

clearly directly applicable to the teachings of Horimai et al (U.S. Patent 5,917,798). See, for example, page 6, lines 20-23, of applicant's specification that references a document directed to wavelength multiplexing.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patent to van Rosmalen is cited to show that recording position information in holographic recordings has been known for a long time. See column 5, lines 1-20, of Rosmalen.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou, can be reached on (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0530.

Jon Henry
Primary Examiner

jwh
April 2, 2002.